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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,304	03/16/2004	Renwei Yuan	131313-1	1968

7590

09/14/2004

GE Global Research  
Docket Room K-1/4A.59  
One Research Circle  
Niskayuna, NY 12309

EXAMINER
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EVANS, GEOFFREY S

ART UNIT	PAPER NUMBER
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1725

DATE MAILED: 09/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/801,304	Applicant(s) YUAN ET AL.	
	Examiner Geoffrey S Evans	Art Unit 1725	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-39 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-9, 11 and 12 is/are allowed.
- 6) ☒ Claim(s) 10, 13 and 22-29 is/are rejected.
- 7) ☒ Claim(s) 14-21 and 30-39 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>20040316</u> . | 6) <input type="checkbox"/> Other: ____.  |

### DETAILED ACTION

1. The use of the trademark "TEFLON" has been noted in this application (see paragraphs 26 and 31). It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

2. Claims 10 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The word "TEFLON" is indefinite because it is a trademark. A Trademark cannot be used in a claim because a trademark refers to the source of the product and is subject to change by the owner of the Trademark.

Respectfully suggest using the generic terminology of "polytetrafluoroethylene" instead of "TEFLON" to obviate this rejection. In claim 29 the meaning of "axially aligned" is unclear since figure 4 shows the rod (element 416 in figure 7) having an axis parallel to the electrode axis but not "axially aligned" within the general meaning of this phrase.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 13,22,23,24 are rejected under 35 U.S.C. 102(b) as being anticipated by Futamura in Japan Patent No. 2-167,623. Futamura discloses a guide bushing for a

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rotatable electrode comprising a bore including a proximal portion (6a), an intermediate portion (13), and a distal portion (12a) sized to be at least partially in contact with the surface of the electrode.

5. Claims 25 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Gleason et al. in U.S. Patent No. 6,127,642. Gleason discloses an auxiliary busing (element 36) operatively connected with the electrode and a support system (elements 38,44 etc.) including at least one arm (38), the arm maintaining the bore of the auxiliary bushing substantially co-axial with the longitudinal axis of the electrode.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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8. Claims 27,28,29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gleason et al. in U.S. Patent No. 6,127,642 in view of Yamada et al. in Japan Patent No. 2001-38,533. Yamada et al. teaches using springs (151,152,153; see figure 1) that dampen movements of the apparatus during machining. It would have been obvious to adapt Gleason et al. in view of Yamada et al. to provide this to dampen the movements of the auxiliary bushing. Regarding claim 29, element 44 of Gleason et al. is considered to be a rod having an axis parallel to the longitudinal axis parallel to the electrode axis.

9. Claims 1-9,11 and 12 are allowed.

10. Claim 10 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

11. Claims 14-21,30-39 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. There is no motivation to adapt the Gleason et al. reference with the teaching of the Futamura reference (or vice versa) to meet the limitations of claim 30.

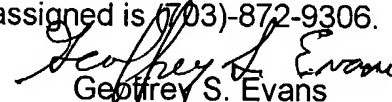
12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Jomen in Japan Patent No. 4-310,322 A discloses using a middle guide to prevent deflection of the electrode.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey S Evans whose telephone number is (571)-272-1174. The examiner can normally be reached on Mon-Fri 6:30AM to 4:00 PM, alternate Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn can be reached on (571)-272-1171. The fax phone number for the organization where this application or proceeding is assigned is (703)-872-9306.

GSE

  
Geoffrey S. Evans  
Primary Examiner  
Group 1700